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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,087	01/28/2000	David Slik	39384	1768
23820	7590	09/13/2004	EXAMINER	
ROYLANCE, ABRAMS, BERDO & GOODMAN, LLP 1300 19TH STREET, NW SUITE 600 WASHINGTON, DC 20036-2680			JASMIN, LYNDA C	
		ART UNIT	PAPER NUMBER	
		3627		

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/493,087	SLIK, DAVID
Examiner	Art Unit	
Lynda Jasmin	3627	NU

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 06 August 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-23 is/are pending in the application.  
4a) Of the above claim(s) 1-8, 12-17 and 20-23 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 9-11, 18 and 19 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 28 January 2000 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/24/00.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group II (claims 9-11, 18 and 19) in the reply filed on August 6, 2004 is acknowledged.
2. Claims 1-8, 12-17 and 20-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman et al. (2001/0013123 A1). Freeman et al. discloses a method of selectively substituting content into content streams for transmission to one or more users comprising the steps of: generating a broadcast data stream having a plurality of content blocks and at least one floating reference content block each of said content blocks comprising content said floating reference being an empty block having metadata transmitting the broadcast data stream (box [0047]), selecting content to be provided in a broadcast data stream via a floating reference content block (via data

transport stream) by comparing and determining an optimal match between at least two criteria selected from the group consisting of a profile of a broadcast station from which said broadcast data stream is transmitted, a profile of an advertisement spot in said broadcast data stream corresponding to said floating reference content block, a profile of a user group comprising a plurality of said users, a profile of one of said users, a profile of said broadcast data stream, and profiles of content available for substitution into said broadcast data stream (via customized programming content transmitting to a user from a transmission center; boxes [0027] and [0033]), and creating a reference content block having at least one of selected content and a reference with which to obtain the selected content from a storage location (via a library of storage server), the selected content corresponding to the optimal match, the reference content block being used in the broadcast data stream in lieu of the floating reference content block (boxes [0027] and [0034]). Freeman further discloses the step of configuring selected the content blocks to refer to different the content blocks depending on which of the users the selected content blocks are intended for (box [0013]), and specifying metadata associated with the content blocks in the broadcast data stream to define which positions of the broadcast data stream are intended for different types of the users, wherein the selecting step comprises the step of determining the optimal match using the metadata (box [0089]).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. in view of Dedrick (5,724,521).

Freeman discloses the elements of the claimed invention, but fails to explicitly disclose determining the number of users receiving the selected content; and deducting an account corresponding to each provider of the selected content. Dedrick discloses the concept of charging a fee to advertiser based on consumer scale matching process associated with an electronic advertisement. From this teaching of Dedrick, It would have been obvious to one of ordinary skill in the art at the time the invention was made to the customized programming of Freeman to include charging a fee to advertiser as

taught by Dedrick in order to facilitate maintenance cost for provider of electronic content.

8. Functional recitation(s) using the word "for" (e.g. "intended for" as recited in claims 10 and 11) have been considered but given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Roop et al. (2001/0014976 A1), Srinivasan et al. (6,357,042), Hidary et al. (2004/0030759 A1), Maissel et al. (2003/0088812 A1) are cited as art of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone

Art Unit: 3627

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lynda Jasmin  
Primary Examiner  
Art Unit 3627

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